

23. (previously presented) A compound according to claim 22 wherein
R¹ is trifluoromethyl,
R² is hydrogen, and
R³ is a pyrimidine.
24. (previously presented) A compound according to claim 22 wherein R¹ and R² are each chloro, and R³ is a pyrimidine.
25. (previously presented) A compound according to claim 1 which has an IC₅₀ of less than 20 μ M when tested in one or both of
(i) an ICAM-1/LFA-1 Biochemical Interaction Assay, or
(ii) an ICAM-1/JY-8 Cell Adhesion Assay
26. (previously presented) A method for ameliorating a pathology in a mammal arising from the interaction of LFA-1 with ICAM-1 or ICAM-3 comprising administering to said mammal a therapeutic amount of a compound according to claim 1.
27. (previously presented) A method according to claim 26 wherein the pathology is selected from an inflammatory disease, an autoimmune disease, tumor metastasis, allograft rejection and reperfusion injury.

REMARKS

I. Status of the Claims

Claims 1-27 are pending in the application. Claims 1, 17, 19, and 20 have been amended. Claim 15 is withdrawn from consideration.

Claim 1 has been amended to require that R¹ and R³ be selected from the recited group. In light of this amendment to claim 1, dependent claims 17, 19, and 20 have

been amended to expand the recited group for R¹ to include the compound of formula II. These amendments are also consistent with the existing provisos in claims 17, 19, and 20 that R¹ be a pyrimidine if R³ does not define a pyrimidine.

Claim 1 has also been amended to define heterocyclyl as chosen from 3-, 4-, 5-, 6- and 7-membered rings to render this definition consistent with the definition of unsubstituted and substituted heterocyclyl for R¹⁰ and R¹¹. Other minor amendments have been made for the purposes of clarity.

No new matter has been added by these amendments, nor do these amendments raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Accordingly, Applicants respectfully request further examination of the claims.

The Examiner recommends that claim 15 be deleted, asserting that it is drawn to a non-elected invention. *Final Office Action* at p. 2. Applicants respectfully disagree. Dependent claim 15 can define a non-pyrimidine so long as the compound of formula I includes a pyrimidine at the R¹ or R³ position, a proviso that is explicitly recited in independent claim 1. Accordingly, Applicants respectfully request examination of claim 15.

II. Objection to the claims

The Examiner has objected to claim 13 as allegedly "drawn to multiple inventions for reasons set forth in the restriction requirement." *Final Office Action* at p. 2. The Examiner further states that "only one of R¹ or R³ is permitted to be a pyrimidine ring." *Id.* at 3.

Applicants respectfully disagree. Both R¹ or R³ can be a pyrimidine so long as at least one of R¹ or R³ defines a group of formula II, which can be a pyrimidine. Stated otherwise, R¹ and/or R³ can be both a group of formula II and a pyrimidine. Claim 13 further limits the group of formula II such that D, B, Y, and Z are chosen from specified radicals. Claim 13 can read on the elected invention whether or not the group of formula II defines a pyrimidine. For example, if claim 13 defines a group of formula II that is not a pyrimidine and this group is assigned as R³, then R¹ is necessarily a pyrimidine (and vice versa). Thus, claim 13 does not have to define a pyrimidine to read on the elected invention by virtue of the proviso in claim 1 requiring that at least one of R¹ or R³ be a pyrimidine.

Finally, Applicants respectfully disagree that "only one of R¹ or R³ is a pyrimidine as was done in claim 20." *Id.* In claim 20, the R³ is selected from four substituents. The third substituent is a pyrimidine. Thus, if R³ is not a pyrimidine, the proviso of claim 20 requires that R¹ be a pyrimidine. If R³ is a pyrimidine, the proviso does not exclude R¹ from being a pyrimidine. Moreover, claim 20 has been amended to clarify this existing proviso to allow R¹ to be selected from the group of formula II, which can define a pyrimidine.

Accordingly, it is respectfully requested that the objection to claim 13 be withdrawn.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

III. Rejection under 35 U.S.C. § 112, second paragraph

Claims 1-14 and 16-27 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. *Final Office Action* at pp. 3-4. Applicants respectfully traverse this rejection.

The Examiner believes that the proviso "one or more than one of R¹ or R³ is a group of formula II as defined above" is not clear. *Id.* at p. 3. The Examiner questions how "more than one of R¹ or R³ is a group of formula II, when applicants indicate that at least one of R¹ or R³ is a pyrimidine." *Id.*

Definiteness under 35 U.S.C. § 112, second paragraph is determined from the point of view of one of ordinary skill in the art. M.P.E.P. § 2173.02. ("[T]he examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope."). Applicants respectfully submit that one of ordinary skill in the art would appreciate that radicals encompassed by formula II are not mutually exclusive from pyrimidines. As stated above, R¹ and/or R³ can be both a group of formula II and a pyrimidine. Applicants provide some examples of compounds that fall within the elected invention:

Example 1. R¹ is a pyrimidine of any formula and R³ is a non-pyrimidine of formula II. (see, e.g., proviso of claim 2). Here, only one of R¹ and R³ is a pyrimidine and only one of R¹ and R³ is a group of formula II.

Example 2. R¹ is a pyrimidine but not of formula II and R³ is a pyrimidine of formula II. Here, both of R¹ and R³ are pyrimidines and only one of R¹ and R³ is a group of formula II.

Example 3. R¹ is a pyrimidine of formula II and R³ is a pyrimidine of formula II. Here, both of R¹ and R³ are pyrimidines and both of R¹ and R³ are groups of formula II.

The claimed invention does not cover the scenarios where neither R¹ and R³ is a pyrimidine or neither R¹ and R³ is a group of formula II.

Applicants respectfully submit that the claim as presented in the previous response to the office action is sufficiently clear. Nevertheless, claim 1 has been amended in accordance with the Examiner's second suggested amendment at p. 4. Claim 1, as amended, defines R¹ and R³ as being chosen from the same list of substituents as for R², R⁴, and R⁵. The provisos remain unamended.

Accordingly, Applicants respectfully request withdrawal of this rejection.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned at (617) 452-1621.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P

By: Maria T. Bautista
Maria T. Bautista
Reg. No. 52,516

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